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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/731,626	12/07/2000	Robert P. Lewandowski	AUS9-2000-0555-US1	1066
35525	7590	07/21/2004	EXAMINER	
IBM CORP (YA) C/O YEE & ASSOCIATES PC P.O. BOX 802333 DALLAS, TX 75380			MEINECKE DIAZ, SUSANNA M	
			ART UNIT	PAPER NUMBER
			3623	

DATE MAILED: 07/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/731,626

Applicant(s)

LEWANDOWSKI, ROBERT P.

Examiner

Susanna M. Diaz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 18-22, 24-31 and 41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 18-22, 24-31 and 41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/26/01.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

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DETAILED ACTION

1. This Non-Final Office action is responsive to Applicant's Election filed May 17, 2004. Applicant has elected Group I (claims 1-8, 18-22, 24-31, and 41) without traverse.

Applicant has cancelled claims 9-17, 23, 32-40, 42, and 43.

Claims 1-8, 18-22, 24-31, and 41 are presented for examination.

Claim Objections

2. Claims 1, 18, 24, and 41 are objected to because of the following informalities:

Claim 1, line 4, insert --of-- after "plurality"

Claim 1, line 8, delete "update", insert --updated--

Claim 18, line 4, delete "as", insert --a--

Claim 18, line 8, insert --of-- after "plurality"

Claim 18, line 8, delete "in which" or "wherein"

Claim 18, line 9, delete the period after "transactions"

Claim 18, line 11, delete "update", insert --updated--

Claim 24, line 4, insert --of-- after "plurality"

Claim 24, line 8, delete "update", insert --updated--

Claim 41, line 4, insert --of-- after "plurality"

Claim 41, line 8, delete "update", insert --updated--

Appropriate correction is required.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-8 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts. As to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble. Furthermore, mere intended or nominal use of a component, albeit within the technological arts, does not confer statutory subject matter to an otherwise

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abstract idea if the component does not apply, involve, use, or advance the underlying process.

In the present case, the only recitations of technology are limited to the preamble and, at best, a nominal recitation of a data structure (which is not even expressly recited as electronic) in the body of the claims. In order to remedy this rejection, it is respectfully suggested that the claims be amended to expressly recite at least one of the core steps of the invention (e.g., analyzing) as being performed by technology (e.g., a computer processor).

Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-5, 7, 8, 18-22, 24-28, 30, 31, and 41 are rejected under 35

U.S.C. 102(e) as being anticipated by Phung (US 2002/0007237 A1).

Phung discloses a method in a data processing system for processing a physical transaction, the method comprising the data processing system implemented steps of:

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[Claim 1] receiving data structures containing information about the physical transactions from a plurality of entities performing the physical transactions, wherein the data structures include information about the physical transactions (¶¶ 10, 11, 37, 38, 42, 46, 50, 51, 55);

updating a database of physical transactions in response to receiving the data structures to form an updated database (¶¶ 10, 11, 37, 38, 42, 46, 50, 51, 55); and

analyzing the updated database to generate statistics about the physical transactions (¶¶ 38, 39, 58, 54, 55, 56);

[Claim 2] analyzing the statistics to generate projections about future physical transactions (¶ 38 – “Various datamining techniques are applied to the data to build models to be used for diagnosis. These datamining techniques include, but are not limited to, statistical methods for estimation, prediction, regression, and correlation analysis. The purpose of these algorithms is to build models that take as input some combination of data including, but not limited to, trouble codes, PID values or symptoms in order to determine patterns in the data that can be used for the diagnosis of vehicles);

[Claim 3] wherein the physical transactions involved automotive services (¶¶ 10, 11, 18, 37, 38, 42, 46, 51, 64);

[Claim 4] wherein the information includes an item in the physical transaction (¶¶ 10, 11, 18, 37, 38, 42, 46, 51, 64);

[Claim 5] wherein the information includes an identification of a vehicle in the transaction (¶¶ 37, 42, 46, 64);

[Claim 7] wherein the plurality of entities are located in different geographic locations (§§ 10, 37, 38, 42, 50);

[Claim 8] wherein the data structures are received using one of electronic mail messages, a floppy disc, or CD-ROM (§ 16).

[Claims 18-22] Claims 18-22 recite limitations already addressed by the rejection of claims 1-5, 7, and 8 above; therefore, the same rejection applies.

As per claims 18-22, Phung's communications are conducted globally over a network that may include the Internet, a modem server, etc. (§§ 12, 37). Inherent to global networks are multiple buses and processors. Depending on how one characterizes the bus system, it may be viewed generally as a single bus on some microscopic level or as a primary and secondary bus on a more macroscopic level. Also, the use of a modem server is indicative of use of a modem.

[Claims 24-28, 30, 31] Claims 24-28, 30, and 31 recite limitations already addressed by the rejection of claims 1-5, 7, and 8 above; therefore, the same rejection applies.

[Claim 41] Claim 41 recites limitations already addressed by the rejection of claims 1-5, 7, and 8 above; therefore, the same rejection applies.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 6 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Phung (US 2002/0007237 A1), as applied to claims 3 and 26 above.

[Claims 6, 29] As discussed above, Phung discloses the analysis of statistics relating to various automotive services, yet Phung does not expressly provide automotive service examples including at least one of an oil change, a tune up, body work on a vehicle, or an alignment. However, Official Notice is taken that it is old and well-known in the art of automobile maintenance/repair that an oil change, a tune up, body work, and an alignment all are well-known types of automotive services performed on vehicles. Phung's invention provides auto mechanics with guidelines for more rapidly and efficiently performing various vehicle services; therefore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to adapt Phung to gather automobile data related to oil changes, tune ups, body work, and/or alignments in order to further assist auto mechanics in more rapidly and efficiently performing these particular services, which are very common in the area of automobile maintenance. Expanding Phung's capabilities to provide service guidelines in a wider range of areas make Phung's invention more versatile and therefore more marketable to a larger body of customers.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Bargnes et al. (US 2003/0171981 A1) -- Discloses a computer implemented vehicle repair analysis system.

Tarnoff ("Database Detectives") -- Discloses the use of data mining to detect insurance fraud.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (703) 305-1337. The examiner can normally be reached on Monday-Friday, 9 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (703) 305-9643.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703)308-1113.

Any response to this action should be mailed to:

**Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450**

or faxed to:

(703)305-7687

[Official communications; including
After Final communications labeled
"Box AF"]

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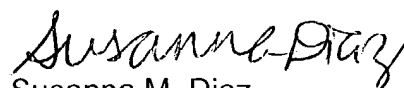
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(703)746-7048

[Informal/Draft communications, labeled
"PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 22202, 7th floor receptionist.



Susanna M. Diaz
Primary Examiner
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July 18, 2004